

REMARKS

Status of the Claims

- Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 are pending in the Application.
- Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162 and 163 are rejected by Examiner.
- Claims 106, 129, 152 are amended by Applicants.

Amendment After Final

Entry of this Amendment is respectfully requested on the ground that this Amendment places the application in condition for allowance. Alternatively, entry of this Amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicants submit that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

Claim Rejections Pursuant to 35 U.S.C. §103 (a)

Claims 106-109 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik in view of the Examiner's rationale. The Applicants respectfully traverse the rejection in light of the amendments to the claims.

Stefik teaches a system for controlling use and distribution of digital works. Stefik allows the owner of a digital work to attach usage rights to their work. The usage rights define how the individual digital work may be used and distributed. Instances of usage rights are defined using a flexible and extensible usage rights grammar. Usage transaction steps define a protocol for requesting the exercise of a right and the carrying out of a right.

(Abstract).

Specifically, Stefik teaches:

A key feature of the present invention is that *usage rights are permanently "attached" to the digital work*. Copies made of a digital work will also have usage rights attached. Thus, the usage rights and any associated fees assigned by a creator and subsequent distributor *will always remain with a digital work*. (Col. 6 lines 62-67).

The attachment of usage rights to the digital content is so important to Stefik, that it is emphasized as follows:

It is fundamental to the present invention that the *usage rights are treated as part of the digital work*. (Col. 11, lines 43-44).

Stefik also uses this permanent attachment of usage rights to digital works in verification steps prior to transferring any digital work. According to the teaching of Stefik:

The check of the usage rights essentially involves a determination of *whether a right associated with the access request has been attached to the digital work* and if all conditions associated with the right are satisfied. (Col. 7, lines 37-41).... If access is granted, repository 1 transmits the digital work to repository 2, step 107. Once the digital work has been transmitted to repository 2, repository 1 and 2 each generate billing information for the access which is transmitted to a credit server, step 108. (Col. 7, lines 42-47).

Applicants submit that a fundamental and key feature of Stefik is the attachment of user rights to the digital content such that a Stefik-defined digital work always has a permanent attachment that includes user rights. Stefik uses this feature and confirms the validity of the combination of digital content and user rights before moving the information from one repository to another. If the Examiner identifies the user rights as being a license, then a distinction between Stefik and the pending claims becomes clear.

Claims 106, 129 and 152 are amended to recite that the license store acts to store the one or more digital licenses without the requested digital content. That is, licenses stored in the license store do not have the requested digital content stored with them. Stefik requires that the user rights (licenses) be permanently attached to digital content and the licenses. The recitals in amended Claims 106, 129 and 152 are in opposition to the teaching of Stefik. As a result, Applicants submit that Stefik teaches away from the invention of amended Claims 106, 129 and 152.

Applicants respectfully submit that Stefik does not teach or suggest, alone or in combination with the Examiners rationale, all the elements of amended Claims 106, 129 and 152. Specifically, the references, alone or in combination, fail to specifically teach or suggest, among other things, the license store storing the one or more digital licenses without the requested digital content. In distinction, Stefik relies on the permanent attachment of the user

rights and digital content and thus teaches away from the recitals of the above mentioned claims. Consequently, Stefik either alone or in combination with rationale, cannot render amended independent Claims 106, 129 and 152 obvious. As a result, these claims patentably define over the cited art.

Similarly, dependent Claims 107-115, 117-119, 122-128 which rely on amended independent Claim 106, dependent Claims 130-138, 140-142, 145-151 which rely on amended independent Claim 129 and dependent Claims 152-158, 162 and 163 which rely on amended independent Claim 152 are also rendered non-obvious and patentably define over the cited art.

Dependent Claims 110-112 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik in view of U.S. Patent No. 6,073,124 to Krishnan et al. Applicants respectfully traverse the rejection in light of the amendment to base Claim 106 and the above response concerning the contrary teaching of Stefik.

Dependent Claims 113-115, 117-119 and 121-128 stand rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik in view of U.S. Patent No. 6,073,124 to Krishnan et al. and in further view of U.S. Patent No. 5,892,900 to Ginter et al. Applicants respectfully traverse the rejection in light of the amendment to base Claim 106 and the above response concerning the contrary teaching of Stefik.

DOCKET NO.: MSFT-0108 / 127334.8
Application No.: 09/482,932
Office Action Dated: 01/11/2005


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Conclusion

Applicants submit that the current amendments to pending Claims 106, 129 and 152 place all pending claims in a condition for allowance. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejections. A Notice of Allowance for all pending claims is respectfully requested.

Respectfully Submitted,

Date: April 11, 1005


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